

REMARKS

Applicants confirm the oral election with traverse of Group I (1-13) drawn to a method of making glass powder.

It is respectfully submitted that the restriction requirement should be withdrawn. The claims of Group II specifically reference the claims of Group I, and therefore the method needs to be consulted when making an examination of the claims drawn to the product. Further, the identification of the primary subclass does not constitute the entire search area for either group and the recitation of the primary subclass does not, therefore, establish a separate status in the art.

Consideration of all of the claims is respectfully requested.

Withdrawal of the rejection of claims 1-13 under 35 U.S.C. § 112, second paragraph is respectfully requested. The term “the oxide-converted amount of said water-soluble compound” very clearly refers to the amount of the water soluble compound when calculated as if it was an oxide. It is respectfully submitted that the language itself was sufficient and no antecedent basis was required but nevertheless, an amendment has been made to improve the idiomatic recitation of the amount.

With regard to the asserted claiming both a broad and a narrow range in the same claim, it is respectfully submitted that on reconsideration the Examiner will recognize that no broad and narrow recitation of a range is set forth in the claims.

The claims refers to decomposing a solution in which the raw material powder has an average particle size which is not more than about 1/5 of the average

particle size of the glass powder. The claim then goes on to indicate that when this condition is satisfied (i.e., not more than about $1/5$ of the average particle size), the decomposition temperature itself satisfies the recited characteristics depending on certain other conditions, one of which relates to the particle size being more than about $1/25$ of the average particle size. In other words, the $1/5$ and $1/25$ relate to different aspects of the claims and do not create an inconsistency by calling for a value in broad and narrow range of the same parameter to be present at the same time.

Claims 1-3 and 10-13 were rejected under 35 U.S.C. § 102 over Kodas or under 35 U.S.C. § 103 over Kodas in view of Yoshikawa; claims 4-13 were rejected under 35 U.S.C. § 103 over Kodas in view of Yoshikawa; and claims 1-13 were rejected under 35 U.S.C. § 103 over Kodas in view of Rosencwaig. All of these rejections are respectfully traversed.

The Kodas patent teaches a spray decomposition method for forming a spherical glass powder. While the Office Action refers on page 6 to “the aluminosilicate glass composition of Kodas”, the reference itself refers to a variety of glasses which may or may not contain any aluminum. See, e.g., column 4, lines 31-35 and column 29, lines 10-27. Kodas further indicates that the percentages of the various components in the liquid solutions can be adjusted, see column 30, lines 34-36 and column 36, lines 39-42. While the Office Action avers that the Yoshikawa shows that “the” aluminosilicate glass composition of Kodas has a particular melting point range, the only specific glass identified in Kodas is that set

forth in the examples (column 37) and it does not contain a glass composition of Yoshikawa (which must contain 10-30 weight percent of an oxide of Mg, Ca or Ba). Moreover, as the Office Action points out, the Kodas spray decomposition temperature can be as low as 300°C, a value which is far less than the melting point of the Yoshikawa glass (700-950°C). Beyond the foregoing, as pointed out at the bottom of page 5 of the Office Action, the raw material oxide powder can have varying sizes which range from larger than the size of the resulting glass particles to less than the size of the resulting glass particles.

It will be appreciated from the foregoing that, at best, Kodas has a disclosure which is generic to the instant the claims (although Applicants respectfully submit that the Examiner has not met the burden of demonstrating that situation). In any event, a generic disclosure is legally inadequate to be an anticipation under Section 102. See, e.g., *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989).

Turning to the rejections based on Section 103, nothing in the Kodas patent has an indication there should be any particular relationship whatsoever between the decomposition temperature and the quantity of the solid and the size of the solid. Accordingly, there is no factual basis on which to base a rejection of obviousness and the rejections should be withdrawn. The Yoshikawa reference does not supply the missing disclosure, particular in that it has been cited only for the proposition that a silicate glass composition has a particular melting point.

As to some of the pending claims, the Examiner will further note that Kodas teaches that the liquid feed preferably contains suspended particulars in an

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amount not greater than about 15 weight percent, and the reference is clearly inadequate to make any suggestion about a decomposition temperature when the concentration is at least three times greater.

The Rosencwaig reference likewise does not cure the deficiencies in Kodas.

In the light of all of the foregoing considerations, withdrawal of the prior art rejections and allowance of the application is respectfully solicited.

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Respectfully submitted,

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